

Republic of Chile Ministry of Economy, Development and Reconstruction	<b>REGULATIONS UNDER LAW NO. 19,039 ON INDUSTRIAL PROPERTY</b>

**SANTIAGO, AUGUST 25, 2005**

**No. 236**

**GIVEN:** Law No. 19,039 and the amendments laid down by Law No. 19,996; Article 32.8 of the Political Constitution, and the provisions contained in Decision No. 520 of 1996, of the Comptroller General of the Republic.

**WHEREAS:**

Law No. 19,996 introduced a broad range of amendments to Law No. 19,039 on Industrial Property;

In accordance with the foregoing, Transitional Article 6 of Law No. 19,996 orders the issuing of Regulations under the Law on Industrial Property,

**HEREBY DECREES:**

Supreme Decree No. 177 of 1991, of the Ministry of Economy, Development and Reconstruction is hereby repealed, and the following Regulations under Law No. 19,039 on Industrial Property are adopted:

## TITLE I

### GENERAL PROVISIONS

**Article 1.**– These Regulations shall regulate the grant and protection of industrial property rights relating to trademarks, patents, utility models, industrial designs, layout designs (topographies) of integrated circuits, geographical indications and appellations of origin.

**Article 2.**– For the purposes of these Regulations, the following definitions shall apply:

- **Application:** hard copy or electronic form generated by the Department, containing the basic information relating to the applicant and the right which is claimed.
- **Claim:** the enunciation and delimitation of that which, in the final analysis, remains protected by a patent or utility model, and which is structured as follows:
  - number;
  - preamble;
  - the expression “characterized”; and
  - the characterization.
- **Claims sheet:** the document containing the body of clear and concise descriptions, formally structured and set out in the description, which is intended to individualize the new aspects for which protection is sought.
- **Department:** the Industrial Property Department of the Ministry of Economy, Development and Reconstruction.
- **Dependent claim:** that which contains the characteristics of another claim and specifies additional details or alternatives.
- **Description:** a document whereby the applicant provides clear and detailed information on his invention, utility model, industrial design, layout design (topography) of integrated circuits, in addition to the prior art relating to said right.
- **Expert:** a professional, specialist or expert who is suited to drafting technical reports.
- **Independent claim:** that which designates the subject matter of the invention and its main characteristics. The claim may contain more than one independent claim from the same or a different category, maintaining the unity of the invention, if the subject matter of the application cannot be adequately covered by a single independent claim.
- **Industrial design classification:** the International Classification for Industrial Designs established under the Locarno Agreement of October 8, 1968 and its subsequent amendments.
- **Law:** Law No. 19,039 or the “Law on Industrial Property” and its subsequent amendments.
- **Multiple dependent claim:** that which refers to more than one claim bearing a lower number from the same sheet.

- **Non-voluntary license:** the authorization granted by the competent authority to a third party to use an invention without or against the consent of its owner, based on one of the grounds set out in Article 51 of the Law.
- **Patent invention classification:** the International Patent Classification established under the Strasbourg Agreement of March 24, 1971 and its subsequent amendments.
- **Prior art:** all knowledge that has been made available to the public anywhere in the world, even though it may be totally unknown in Chile, by means of a publication in tangible form, sale or marketing, use or any other means, prior to the filing date of an application or claim of priority for an industrial property right in Chile.
- **Priority:** the strongest right that an applicant can claim in filing an application, because he requested it previously in Chile or abroad. A priority claim is a right that guarantees the person who has filed an application abroad that he may also file it in Chile, within the period of time established by law or an international treaty ratified by Chile.
- **Royalty:** periodic compensation, remuneration or payment which the licensee must make to the holder of an industrial property right, for the corresponding license for use.
- **Technical equivalent:** an element or means that performs the same function as the one claimed in an invention, in the same manner and producing the same effect or result as the one indicated in the claim.
- **Title:** document issued by the Department in accordance with the rules contained in these Regulations, attesting the grant of an industrial property right.
- **Trademark classification:** the International Classification of Goods and Services established under the Nice Agreement of June 15, 1957 and its subsequent amendments.
- **Utility model classification:** the International Patent Classification established under the Strasbourg Agreement of March 24, 1971 and its subsequent amendments.

**Article 3.**– The faculty to require that an industrial property right shall belong to its true creator or inventor or to his heirs or assignees, without prejudice to the special rules that apply to service inventions and to geographical indications and appellations of origin.

Industrial property rights which, in accordance with the law, are subject to registration, shall be fully valid as from their registration, without prejudice to the rights to which the applicant is entitled and the other rights set out in law.

## TITLE II

### APPLICATIONS AND SUPPORTING MATERIAL

**Article 4.**– All applications for registration of industrial property rights shall be filed with the Industrial Property Department of the Ministry of Economy, Development and Reconstruction by means of a pre-printed form or via the Department’s website.

Rights applications may be filed directly by the interested parties or agents or representatives with special entitlement for that purpose, in the form established by these Regulations.

**Article 5.**– All pre-printed forms shall be filed in duplicate with the Department through its Reception Office. Each application shall clearly state the day on which it was filed.

These applications shall be stamped strictly in the order in which they are received and shall be assigned a corresponding number which they shall keep through the entire procedure.

Electronically transmitted applications that are received by the Department between 00:00:01 a.m. and 2:00:00 p.m. shall be assigned the day of electronic receipt as the date of entry. In this case, the entry number for applications shall be assigned accordingly as per the time of receipt, starting with the last number assigned to applications received electronically on pre-printed forms between 09:00:01 a.m. and 2:00:00 p.m., on the day of receipt.

Electronically transmitted applications that are received by the Department between 2:00:01 p.m. and 00:00:00 a.m. shall be assigned the day of electronic receipt as the date of entry. In this case, the entry number for applications shall be assigned accordingly as per the time of receipt, starting with the last number assigned to applications received electronically between 00:00:01 a.m. and 2:00:00 p.m., on the day of receipt.

The Department shall notify the applicant electronically of the receipt, date and corresponding number assigned to the electronic application.

**Article 6.**– All applications shall be accompanied by any other supporting documents that the Law and these Regulations shall establish in each case.

**Article 7.**– The applicant shall indicate in the application the number, date and place of the grant of the same right or of any other application filed in respect of the same subject matter for which protection is sought in Chile. At the request of the Department, where this is required by law, the applicant shall submit the reports or rulings issued abroad in respect of the right for which protection is sought in Chile, duly translated into Spanish.

**Article 8.**– A copy of the application, duly stamped with an indication of the date and corresponding number, shall be given to the applicant. In the case of electronic applications, this shall be done in accordance with the provisions of Article 5 of these Regulations.

**Article 9.**– All applications for the registration of trademarks shall contain the following:

(a) complete name or company name, tax identification number and address of the person concerned and the same information on his agent or representative, if any;

(b) a clear specification of the trademark. Marks consisting of known expressions in foreign languages must be submitted with the Spanish translation;

(c) a list of the goods and/or services that shall bear the trademark and the class(es) of the International Classification for which protection is sought. In the case of business or industrial establishments, it shall be necessary to specify the goods and the classes to which they belong and the region(s) for which the registration of a trademark is sought to distinguish a business establishment;

(d) date of filing of the application and signature of the applicant or his agent.

**Article 10.**– All trademark applications shall be accompanied by the following:

(a) for the registration of a label, six paper drawings thereof, measuring at least five centimeters by five centimeters and, barring exceptions made by the Director of the Department, a maximum of 20 centimeters by 20 centimeters.

Where the label is submitted electronically, this shall be done in accordance with the specifications and standards compatible with the Department's systems.

In the former case, the publication, registration, title, certificate and copies of the label shall be made in accordance with the print generated by the electronic submission, which shall be considered to be the sign sought for all purposes;

(b) for the registration of a proper name, it shall be necessary to include documents proving that said name belongs to the applicant, or documents containing the consent referred to under Article 20(c) of this Law. If registration is sought for a fictitious name that does not correspond to a natural person or legal entity, it shall be accompanied by a sworn statement to that effect;

(c) in the case of agents or representatives, a power of attorney granted in accordance with Article 15 of the Law;

(d) where the holder of the application is a legal entity, documents specifying the legal personality of the representative, if he is not the same as the one referred to under subparagraph (c);

(e) in the case of sound marks, it shall be necessary to include a graphic representation and a sound recording, using specifications and standards that are compatible with the Department's corresponding systems.

(f) proof of payment of the fees.

**Article 11.**— Applications for patents or utility models shall contain the following:

(a) complete name or company name, tax identification number and address of the person concerned or his agent or representative, if any;

(b) complete name of the inventor, nationality and address;

(c) title of the invention;

(d) number, place and date of the first application filed abroad, if any;

(e) formal statement of novelty, ownership and usefulness of the invention, in accordance with Article 44 of the Law;

(f) signature of the applicant and/or his representative.

In the case of agents or representatives, applications shall be accompanied by a power of attorney granted in accordance with Article 15 of the Law.

Where the holder of the application is a legal entity, applications shall be accompanied by documents specifying the legal personality of the representative.

If the applicant is not the same person as the inventor, it shall be necessary to include a duly authenticated assignment of rights.

In addition, the applicant, when filing his application, shall include proof of payment of the fees and documents referred to in Articles 43 and 58 of the Law, depending on whether an invention patent or utility model is involved, respectively. Documents shall be submitted in Spanish.

**Article 12.**– Applications for industrial designs and layouts (topographies) of integrated circuits shall contain the following:

- (a) complete name or company name, tax identification number and address of the person concerned and the same information for his agent or representative, if any;
- (b) complete name, nationality and address of the creator;
- (c) title;
- (d) formal statement of the conditions laid down in Article 44 of the Law, as applicable;
- (e) signature of the applicant and/or his representative.

In the case of agents or representatives, it shall also be necessary to include a power of attorney granted in accordance with Article 15 of the Law.

Where the holder of the application is a legal entity, it shall be necessary to include documents specifying the legal personality of the representative.

If the applicant is not the same as the creator, a duly authenticated assignment of rights shall be attached.

In addition, the applicant, when filing the application, shall include proof that the fees have been paid as well as the documents referred to in Articles 64 and 80 of the Law, depending on whether an industrial design or a layout (topography) for integrated circuits is involved, respectively. Documents shall be submitted in Spanish.

**Article 13.**– All applications for a geographical indication or an appellation of origin shall contain:

- (a) the applicant's name, address, tax identification number, as applicable, and activity, in relation to the indication or appellation requested and those of his agent or representative, if any;
- (b) the geographical indication or appellation of origin;
- (c) an indication of the country of origin of the geographical indication or appellation of origin;
- (d) the geographical area of production, extraction, processing or preparation of the product distinguished by the indication or appellation, delimited in terms of the country's geographical characteristics and political and administrative divisions;
- (e) a detailed description of the product or products to be distinguished by the indication or appellation sought, as well as their essential characteristics or qualities;
- (f) where the applicant is an authority, a specific reference to the post he holds and the administrative act whereby he was appointed;
- (g) the signature of the applicant and/or his representative. In the case of agents or representatives, applications shall be accompanied by a power of attorney granted in accordance with Article 15 of the Law.

The following documents shall also be attached:

- (a) a technical study, drawn up by a competent professional, providing supporting information to the effect that the characteristics or qualities assigned to the product are fundamentally or exclusively attributable to its geographical origin;
- (b) specific draft regulations for the use and supervision of the indication or appellation sought;
- (c) a map drawn up using Universal Transverse Mercator coordinates, of the specific geographical area of production for the geographical indication or appellation of origin for which protection is sought;

- (d) in the case of a foreign geographical indication or appellation of origin, documents justifying the existence and origin thereof; except where they have been previously recognized by international treaties ratified by Chile;
- (e) where the applicant is a legal entity, documents specifying the legal personality of its representative;
- (f) proof that the fees have been paid.

All documents shall be included in digital form on the basis of specifications and standards compatible with the Department's corresponding system.

Documents shall be submitted in Spanish.

**Article 14.**– The applicant shall arrange for the publication referred to in Article 4 of the Law to appear in the Official Gazette under his responsibility, within 20 days following acceptance for processing in the case of trademarks and 60 days for patents, utility models, industrial designs, layout designs (topographies) of integrated circuits and geographical indications and appellations of origin.

Publications shall contain at least the following:

In the case of trademarks, the application number, the complete name or company name of the applicant, the trademark requested and the label, as applicable, and an indication of the coverage sought.

In the case of patents, utility models, industrial designs and layout designs (topographies) of integrated circuits, the application number, complete name or company name of the applicant, and an explanatory abstract of the content of the right for which protection is sought.

In the case of geographical indications or appellations of origin, the application number, complete name or company name of the applicant, designation of the geographical indication or appellation of origin, a description of the product or products to be distinguished and the geographical delimitation within which it shall apply, with an indication of the Universal Transverse Mercator coordinates for which protection is sought.

Applications for trademarks, geographical indications or appellations of origin, for which no abstract has been published during the period mentioned in this Article, shall be deemed not to have been filed. Similarly, in the case of patents, utility models, industrial designs or layout designs (topographies) of integrated circuits, the application shall be deemed to have been abandoned and shall be shelved.

Non-substantive publication errors may be corrected by means of a decision issued *ex officio* or at the request of one of the parties.

Substantive publication errors shall require new publication within 10 days, beginning from the date of the decision ordering such publication.

Differences of colors or minor distortions of form that may occur normally in the publication process shall not affect the validity of publication.

### TITLE III

#### JOINT PROCEDURE FOR OBTAINING A RIGHT

**Article 15.**– All applications for industrial property rights shall be filed in Spanish. The Department shall put together a file containing the filings, documents, steps and supporting material relating to the procedure for the grant of the right, including the stages in the appeal process, if any, ending with a final decision by the Department.

**Article 16.**– Applications may be filed on behalf of one or more persons. In the latter case, a joint agent or representative shall be appointed.

Any community of rights arising from the application shall be regulated by common law. However, if there are indivision agreements or other instruments relating to the community, they may be attached at any time and shall be added to the file or entered in the margin of the registration, if the privilege has already been granted.

**Article 17.**– The preliminary examination shall be conducted by the Department, which shall verify that the filing meets the requirements set out in Articles 14, 15, 43, 58, 64 and 80 of the Law and Articles 11 and 12 of these Regulations, as the case may be.

A preliminary examination report shall be prepared indicating the type of application involved (patent, utility model, industrial design or layout design (topography) of integrated circuits), a preliminary technical classification and the observations relating to the application. In addition, the Department's experts shall prepare the extract for publication which, in their opinion, best interprets the subject matter sought.

The preliminary examination shall indicate the most representative drawing(s) of the invention, utility model, industrial design, or layout designs (topographies) of integrated circuits, so that a picture thereof may be included in the publication referred to in Article 14 of these Regulations. For this purpose, the respective decision shall specify which of the drawings are to be published and shall order that they be uploaded in digital format where they are not thus available, based on the specifications and standards compatible with the Department's corresponding systems.

**Article 18.**– The applicant or his representative expressly authorized by him, may at any stage of the procedure withdraw all or part of his application.

**Article 19.**– Once a final decision to grant an industrial property right has been handed down and proof has been provided that the corresponding fees have been paid or once a final decision has been handed down to grant a benefit established in Article 18bis A of the Law, the registration shall be prepared and the respective title shall be granted. This title shall be signed by the Director of the Department and by the respective Registrar, depending on the type of right involved.

**Article 20.**– In the event of a conflict between two or more applications for industrial property rights, the application which reached the Department first shall have priority, without prejudice to the due process to be exercised with the Director of the Department in order to determine the real creator.

**Article 21.**– Should an applicant wish to opt for delayed payment of the fees laid down in the Law, he shall attach a written request to this effect to the respective application, accompanied by a sworn statement that he lacks financial means and the other documents needed to substantiate this, such as a social welfare report and earnings certificates.

If the applicant is unable to prove that he lacks financial means, the Department shall issue a decision requiring payment of the corresponding fees within 30 days.

Any fees and charges that have been postponed in accordance with this Article shall be paid within two years following the grant of the rights referred to in Article 18 of the Law. Before the expiration of this period, the applicant may request a two-year extension. The Department shall declare that the right has lapsed if payment is not made within the periods stipulated above.

In the event that the facility established in Article 18bis A of the Law is granted, the application shall be deemed to have been abandoned for good or withdrawn, and in the same decision the Department shall order on valid grounds that payment be made within 30 days of all the postponed amounts. This provision shall not apply if the application is definitively rejected under Article 18 of the Law.

**Article 22.**— The decision authorizing the registration of any industrial property right shall be notified via registered letter, without prejudice to its inclusion in the daily bulletin.

The letter may consist of a card or document issued by computer, which should state at least the following:

- (a) the fact that the Department has issued a decision and the date thereof;
- (b) the application number;
- (c) the name and address of the applicant or his representative;
- (d) the e-mail address that may be consulted to ascertain the status of the application. Inability to access this e-mail address or the lack of relevant information at that address shall not affect the validity of notification.

The letter shall be sent to the address indicated in the application or cover of the file or in the computerized database at the time of its sending, depending on whether it is prepared manually or automatically. In case of a change of address, it shall be the responsibility of the applicant to inform the Department in writing and to request that the address be corrected in the respective database, cover or application.

In such cases, notification shall be deemed to have been made three days after the letter has been mailed.

#### **TITLE IV**

#### **TRADEMARKS**

**Article 23.**— The term “trademark” means any sign that can be represented graphically and is suitable for distinguishing in trade products, services or industrial or business establishments. Similarly, it shall be possible to register promotional or advertising slogans, provided that they accompany or are added to a registered trademark for the product, service or business or industrial establishment for which they are to be used.

A trademark consisting of a letter or number must necessarily be represented graphically, with a characteristic design that makes it distinctive.

Applications involving advertising slogans shall be filed solely as names and not be included in a label.

**Article 24.**— Once a trademark application has been filed, it shall be for the Registrar to verify compliance with the formal requirements for registration and order the corresponding publication.

If during this examination the Registrar detects any error or omission, he shall notify the person concerned so that that person may make the necessary corrections or clarifications within 30 days, failing which the applicant's date of priority shall be lost. If the correction is not made during the period set, the application shall be deemed to have been abandoned. The decision declaring the application abandoned may be appealed to the Director of the Department, in accordance with general rules. If the correction is not made or the appeal is not accepted, the application shall be deemed to have been abandoned.

Once the deadline for filing objections has expired, the Director of the Department shall analyze the substance of the application, noting if there are grounds that would warrant its rejection *ex officio*.

These comments shall then be forwarded to the applicant, together with any objections filed, within 30 days. Once this deadline has expired, regardless of whether the comments have been forwarded, the Director of the Department shall issue a final decision accepting or rejecting the trademark, receiving the evidence or summoning the parties to hear the sentence, depending on whether voluntary or disputed files are involved, respectively. In the final decision, the application may not be rejected on grounds other than those contained in the oppositions or the observations of the Director of the Department.

**Article 25.**— Figurative trademarks, whether they are labels or mixed, shall be reproduced in a paper drawing with the exact colors for which registration is sought.

Where the figurative trademark is filed in electronic form, this shall be done in accordance with the specifications and standards referred to in Article 10 of these Regulations.

**Article 26.**— With regard to service trademarks, it shall not suffice to indicate the class; rather, it shall be necessary to specify clearly and precisely the type, orientation or heading of the service for which protection is sought.

A mark registered for a business or industrial establishment shall not protect the goods sold or manufactured therein, unless a registration is filed to protect said goods.

**Article 27.**— Registrations of marks to distinguish products, services and industrial establishments shall be valid throughout the Republic.

Registrations of marks to protect business establishments shall serve only for the region in which the establishment is located. If the interested party wishes to extend ownership of the same mark to other regions, he shall mention this in his application for registration and shall pay the corresponding application or registration fee for each region.

**Article 28.**— The Director of the Department may commission reports from other bodies or entities, where legal or regulatory norms so stipulate. In addition, he may request such a report where he deems such information relevant for a better understanding of the matter, depending on the technical knowledge which those bodies possess.

**Article 29.**— Registered marks shall be used in the same form as their registration was accepted, without prejudice to the other formalities contained in these Regulations. Reducing or expanding the size of the figurative or mixed mark shall not affect protection, if the other legal and regulatory requirements are met.

**Article 30.**— Where the holder of a registered mark fails to apply for its renewal within the legal period, the mark shall be deemed to have been abandoned and the rights to have lapsed.

**Article 31.**– The mark shall confer upon its holder the exclusive and exclusionary right to use it in trade in the form in which it has been granted and to distinguish the products, services, business or industrial establishments covered by the registration.

**Article 32.**– Applications for the renewal of a mark may be filed within the 30 days following the expiration of their term of validity.

Renewed applications shall be valid from the date of expiration of the mark that is the subject of the application for renewal.

The Registrar shall request any corrections or modifications he deems necessary in respect of non-claimable elements that may figure in the registration whose renewal is sought.

## TITLE V

### INVENTIONS

**Article 33.**– To determine the inventive step referred to in Article 35 of the Law, consideration shall be given to the level of knowledge existing in the respective technical sector.

**Article 34.**– Where the application is filed using the pre-printed form, it must be submitted on durable matt white paper of “A4” size (29.7 cm x 21.0 cm) or office size (32.6 cm x 21.6 cm). Once the size has been chosen, this shall remain the same for the duration of processing.

Applications shall be typed in black indelible ink on one side only, without corrections, erasures or writing between the lines.

Documents to be submitted shall have the following margins: upper – 3.0 cm.; left – 3.0 cm.; lower – 3.0 cm.; and right 2.0 cm.

**Article 35.**– Units shall be expressed in the metric decimal system and in degrees Celsius.

Notwithstanding, in cases where separate units are expressed, their equivalent shall be added in the metric decimal system and in degrees Celsius, keeping the original units in brackets.

The symbols, terminology or units used in the forms accompanying any description shall only include those that are generally accepted in the respective science or art and shall be used in a consistent fashion throughout the application.

**Article 36.**– All inventions shall have a title initially determined by the applicant, which shall be clear and precise, in such a way that a person skilled in the art may gain an idea of the technical problem that is resolved and the manner in which it is solved.

Under no circumstances shall made-up words be accepted or words that do not have a clearly established meaning in the art or specialization involved.

Nevertheless, once the application and technical background have been examined, the expert or examiner may suggest to the Director of the Department a new title for the invention that is more consistent with the requirements set out in the first subparagraph of this Article.

**Article 37.**– Applicants who claim to have made disclosures such as the ones referred to in Article 42 of the Law shall include in their patent application the documents proving the existence, nature and date of the disclosures indicated in the said Article.

**Article 38.**– The abstract shall have a maximum of 1,600 characters and shall contain a summary of the invention and an indication of the technical field or industrial sectors in which it is applicable. It shall be submitted as a sheet which the Department shall make available to the public.

The abstract shall make possible a basic understanding of the technical problem that is resolved, its solution and application, and may also include a figure representing the invention.

**Article 39.**– The description of the invention shall be submitted as a separate text and shall include a description of the prior art, a description of the drawings (if any), a description of the invention and an example of an application, as the case may be.

The description of prior art in the field shall begin with an introduction of the suitable field of application for the invention, with a reminder of the technical problem that is taken up and a reference to the solutions found to said problem. These solutions shall be demonstrated to be as feasible and up-to-date as possible – from a technological standpoint – with an analysis of the technical drawbacks or disadvantages.

The description of the invention shall consist of a detailed and clear explanation of the invention in respect of the parts or pieces numbered in the drawings if any, and shall be sufficiently complete so that a person specialized in the industrial sector in question may “reproduce the invention”.

Where the invention contains living biological material, including viruses, or the procedure for obtaining such material, in such a way that the invention may not be fully reproduced in the description, the Department may request that said material be deposited with a body internationally recognized for that purpose, in which case a reference to the institution and respective registration number shall be included.

The example of the application of the invention shall consist of a detailed explanation of at least one way of carrying out the invention, and shall be supported or illustrated with the help of drawings if any, in such a way that it can be used to reproduce the invention.

**Article 40.**– An application may only refer to one invention. It may also refer to a group of inventions which maintain the unity of the invention, that is to say, which are related in such a way that, taken together, they form a single general inventive concept.

The fact that a patent is granted in violation of the principle of unity of invention shall not be grounds for invalidation of the right. However, once this circumstance has been noted, and at the request of the holder, the Director of the Department shall divide the invention, for the time remaining until expiration. The decision of the Director of the Department ordering the division of the patent shall be notified to the holder via registered letter, after which the new titles shall be extended and a corresponding entry shall be made in the original registration.

It shall only be possible to protect a single basic solution to a problem of the art in a single application. Accordingly, each of the clauses shall converge towards the independent claim(s) by means of appropriate links, provided that these maintain unity of invention.

**Article 41.**– The claims shall define the subject matter that shall be the subject of protection and shall be substantiated in the description. They shall consist exclusively of a description of the specific means leading to a new result. They shall be preceded by an Arabic numeral and shall be as many as necessary to define and delimit the invention properly.

The content of the claims shall be self-sufficient. Accordingly, they may not refer to parts of the description unless this is absolutely necessary, in which case this shall be specified in the respective

expert report on the invention. Nevertheless, the claims may also include the numerical references mentioned in the drawings accompanying the application.

**Article 42.**– The claims sheet shall be submitted as a separate text and shall contain a first independent clause designating the subject matter of the invention and its main characteristics which may be spelled out in the following claims.

The claims shall be ordered using an Arabic numeral, a preamble, the expression “characterized” and the characterization in question.

Sentences such as “according to the accompanying drawings” or “in accordance with the explanation in the attached description” etc. shall not be accepted in the claims.

**Article 43.**– The preamble of the claim shall define the invention in the field referred to with an indication of the technical solution which is claimed to be solved. This part of the clause shall include those elements which the invention has in common with the prior art, and shall therefore not include new elements.

The preamble shall be followed by the characterization of the claim linked by the expression “characterized”. That expression must always be present in each of the clauses, and is designed to separate the preamble from the characterization so as to allow them to be distinguished, and must be indicated in bold or upper-case letters, to facilitate its location upon arrival.

The characterization shall be the core of a clause defining the elements, combinations or groups of combinations, which are encompassed by the technical step that meets the conditions of industrial applicability, novelty and inventive step, thereby qualifying for the grant of a patent. These elements shall be present in each of the claims, the first of which shall serve to reconstruct the invention, while the dependent claims shall serve to specify said elements.

**Article 44.**– The definition of the invention as such, as it will ultimately remain protected by the industrial property right that is granted, shall consist exclusively of the content of the claims sheet accepted by the Department. However, the description and the drawings shall be used to interpret the claims.

Each application shall contain one or more independent claims, provided that they correspond to the same inventive unit and are duly related.

A claims sheet shall include an independent product claim which may be related to an independent claim for a process or procedure specifically designed for its manufacture and with a claim individualizing the apparatus or means created specially for that purpose.

Dependent claims shall be defined as those which include characteristics of one or more previous claims in the same category. They shall always refer to the number(s) of the claims on which they depend, followed by the additional characterization incorporating the limits to the claim on which they depend. They shall preferably be grouped together followed by the claim on which they depend.

A multiple dependent claim may be used as a basis for a new dependent claim.

**Article 45.**– The applicant or his representative specially designated for that purpose, may renounce one or more of the claims contained in his application or modify them in the way indicated by the Department.

**Article 46.**– The term “drawings” means sketches, flow charts and graphs. The submission may contain any of these categories, in which case they shall be produced by means of a technical or

conventional tracing which must be in black, and may not be marked and delimited by lines or include any kind of label.

Drawings shall be submitted in a separate part. They shall be rendered with clarity, and in a scale allowing them to be reduced with definition of details. They may contain one or more figures, which shall be numbered accordingly.

**Article 47.**— Flow charts may contain isolated words, provided that they are used frequently in the art, such as entry, exit, mixing, configuring, oxidizing or others.

Graphs shall contain two types of annotation for each reference axis; symbols, words or words with physical or chemical parameters, represented by the coordinate axis, and a symbol of the unit in the metric decimal system, with additional details of the parameters and units to be given in the description. Where it is necessary to distinguish different sections on the curves of the graph, this shall be indicated by means of numerical references, which shall be contained in the description.

**Article 48.**— Drawings shall be produced on paper, in accordance with the provisions of Article 34, subparagraphs 1 and 2 of these Regulations, in either office or A4 size, with tracings on a single side of the sheet, in black.

Drawings and figures shall not contain explanatory texts, which shall be incorporated in the description.

Figures shall not be enclosed and shall retain proper proportions and scale between their various elements, parts and pieces.

Without prejudice to the foregoing, if drawings are submitted in electronic form, this shall be done in accordance with requirements and standards compatible with the Department's corresponding systems.

**Article 49.**— The applicant may, until the respective expert report has been issued, amend his application, provided that this does not entail a broadening of the field of the invention or disclosure contained in the description. The priority of the amendment shall be that of the application.

Likewise, the applicant may divide his application into two or more applications, up until the expert report is issued, provided that this does not broaden the field of the invention or content of the description.

**Article 50.**— The Department may at any stage in the procedure decide to amend or divide the patent application, where in its judgment it provides two or more solutions to a given technical problem and these solutions may be substantiated independently of each other.

Similarly, it may merge applications offering technical solutions that are not viable separately or depend mutually on each other and produce the same result.

In any case, the division of an application shall give rise to one or more new applications, as the case may be, which shall retain the local priority of the original application.

**Article 51.**— Patents shall be granted for a non-renewable period of 20 years, beginning from the date of filing of the application.

## TITLE VI

## UTILITY MODELS

**Article 52.**— All provisions relating to patents shall apply, as relevant, to utility models.

All applications for utility models shall be accompanied by the documents indicated in Article 58 of the Law.

## TITLE VII

### INDUSTRIAL DESIGNS

**Article 53.**— Applications for industrial designs shall be accompanied by the documents indicated in Article 64 of the Law.

All provisions relating to invention patents shall apply, as relevant, to industrial designs.

**Article 54.**— The description shall be organized into an introduction, a description of the drawings and a description of the geometry, as applicable.

In the description of the drawings, the number for each figure shall be matched with its general meaning, without entering into geometry-related details and with an indication of the type of view presented.

In industrial designs, the introduction shall indicate the industrial purpose involved and the preferred application.

In the description of the design, detailed indications shall be provided as to the geometric characteristics of the design, with a reference to the relative proportions or dimensions, without an expression of specific units, for each of the elements that configure the design, in such a way that it is possible to reconstruct the image of the object by merely reading this description.

**Article 55.**— The drawings for the design shall contain at least a view of the upper level, an elevation view, a profile view and a perspective view. Other views may be required, depending on the complexity of the design.

In the case of industrial designs, a representation in one plane of the reproduction of the drawing for which protection is sought shall suffice.

Photographs may be included as a complement, but may not replace the drawings. All of the figures in the drawings shall be numbered and submitted with a photostatic duplicate.

The Department may require the submission of a prototype or model in cases where it deems this appropriate.

**Article 56.**— Industrial designs shall give rise to registrations independent of each other.

**Article 57.**— For the purposes of determining the novelty of industrial designs, drawings, designs or figures constituting part of another intellectual property right such as marks, copyrights or utility models etc. shall also be considered prior art.

## TITLE VIII

### PRIORITY FOR APPLICATIONS

**Article 58.**– The priority date in Chile for any industrial right shall be that of the filing of the respective application with the Department.

Where the applicant alleges the existence of disclosures referred to in Article 42 of the Law, this shall be done together with the filing of the application, accompanied by a document indicating these allegations and what the publications consist of. The corresponding documentation available at the time of filing shall be attached to the document in question.

**Article 59.**– Rights applied for in Chile that claim the priority of an application filed abroad shall also remain subject to the rules set out in the Law and these Regulations.

**Article 60.**– The right of priority for an application filed abroad shall be invoked at the time of filing the application in Chile, and a special reference shall be made thereto indicating the number, date and country in which the application for which priority is sought has been filed.

It shall also be necessary to include the respective certificate of priority issued by the competent authority of the country of origin of the priority.

This certificate shall be submitted within a period of 90 days beginning from the date of filing in Chile of the respective application, duly translated into Spanish, as the case may be. A priority that has not been certified within this period of time shall not be considered in the file.

**Article 61.**– The priority may only be claimed within the periods established under law or in an international treaty ratified by Chile authorizing such a priority.

**Article 62.**– Any industrial property right may be constituted, even during the period for claiming a priority, according to the law or to international treaties signed by Chile, without prejudice to a stronger right that a third party might assert in conformity with the law or said international treaties.

## **TITLE IX**

### **RIGHTS AND OBLIGATIONS ARISING FROM AN INDUSTRIAL PROPERTY RIGHT**

**Article 63.**– The holder of an industrial property registration shall enjoy an exclusive and exclusionary right to use, market, assign or transfer in any way, the subject of the protection and the right that has been conferred.

The protection shall extend until midnight of the same day on which the registration expires, without prejudice to renewal in the case of trademarks.

## **TITLE X**

### **ASSIGNMENTS AND NOTES**

**Article 64.**– Any assignment of an industrial property right as well as any encumbrance on it or on a license granted to a third party shall be made by the corresponding instrument, which shall be noted in the margin of the registration and shall be binding on third parties only as from the entering of said note, subject to acceptance and payment of the respective fees.

The transmission of rights upon death shall be evidenced by means of an entry in the margin of the registration, and shall be accompanied for that purpose by the respective actual possession, subject to acceptance and payment of the respective fees, failing which said transmission shall not be binding on third parties.

**Article 65.**— A trademark that was registered in more than one class may be transferred in respect of all or some of said classes, provided that there is no relationship between the coverage for the divided registrations. The original registration shall be divided and registered using the corresponding numbering, but shall retain the priority and seniority of the original registration for all purposes.

In the original registration, a record shall be kept of the division and of the new numbers assigned to the divided registration.

**Article 66.**— In the event that a precautionary measure is ordered, a note shall be made in the respective registration, and a copy of the decision ordering the measure shall be kept as a background document.

## TITLE XI

### BOOKS AND REGISTERS TO BE KEPT BY THE DEPARTMENT

**Article 67.**— The Department shall keep a Special Register for each type of industrial property right recognized by the Law, in which references to at least the following shall be recorded:

- (a) corresponding number for each protected right;
- (b) complete name or company name, address and tax identification number, as applicable, of the holder;
- (c) name, title or subject matter of the protected right, as the case may be;
- (d) date of filing of the application and grant of the right;
- (e) notes.

**Article 68.**— Certificates to be issued by the Department in respect of the validity, registration, encumbrances, transfers or other acts relating to each right shall be produced on the basis of the contents of the respective registers, and may be extended by electronic means.

Registrations for patents, utility models, industrial designs and layout designs (topographies) of integrated circuits shall be the responsibility of the Patent Registrar, whereas registrations of marks and geographical indications and appellations of origin shall be the responsibility of the Marks Registrar.

**Article 69.**— The Department may keep one or more copies of such registrations by means of computer or other files, duly updated, which shall be copies of the original registration.

Registrations shall be available to the public, and may be consulted while observing the due care necessary with documents of this nature.

## TITLE XII

### NON-VOLUNTARY LICENSES

**Article 70.**— Non-voluntary licenses may be revoked or modified according to Article 51bis D of the Law.

## TITLE XIII

### LAYOUT DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

**Article 71.**– All provisions relating to patents shall apply to layout designs (topographies) of integrated circuits, as relevant.

**Article 72.**– All applications for layout designs (topographies) of integrated circuits shall be accompanied by the documents indicated in Article 80 of the Law.

The prototype or model shall enable the topography to be identified and graphically represented , in such a way as to reveal the three-dimensional structure by means of drawings, photographs or both. Photographs shall be submitted as prints or in electronic form, according to specifications and standards compatible with the Department’s systems and requirements.

The structure to be disclosed shall correspond to:

- (a) the diagrams for manufacturing the product;
- (b) the masks or part of the masks for manufacturing the product;
- (c) the different layers of the product.

These may be accompanied by any complementary documents that the applicant deems necessary for representing and individualizing the product.

**Article 73.**– The term of protection of the layout designs (topographies) of integrated circuits shall begin from the date on which the application for registration is filed or the first commercial exploitation anywhere in the world. To this end, the expert report shall declare expressly whether it has identified any document which in good faith is from this date, or the date of the oldest application for registration abroad, which shall be taken as the date of commercial exploitation instead of the other date. If none of these dates applies, the period shall begin from the date declared by the applicant in accordance with Article 81 of the Law. Under no circumstances shall the term of protection begin from a date later than that of the filing of the application.

## TITLE XIV

### GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN

**Article 74.**– As applicable, the rules of Titles I and II of the Law and the regulatory provisions relating to trademarks shall apply to procedures for examination, publication, registration and invalidation of geographical indications and appellations of origin.

All provisions relating to trademarks shall apply to geographical indications and appellations of origin, as relevant.

**Article 75.**– The Register of Geographical Indications and Appellations of Origin shall be kept by the Registrar of Marks.

**Article 76.**– The draft regulations for use and supervision referred to in Article 97(f) of the Law may only refer to the form and conditions of production of the goods that are to use the geographical indication or appellation of origin.

**Article 77.**– The Register of Geographical Indications and Appellations of Origin shall contain the references indicated in Article 99 of the Law, the number of the respective application, a reference to the existence of the regulations for use and supervision, which do not have to be included in the registration, in which case it shall be necessary to indicate the public site where they can be accessed by interested persons. Compliance shall be achieved with this requirement, as they must be available in physical or electronic form.

**Article 78.**– In the case of foreign geographical indications or appellations of origin, they may be registered in Chile regardless of the name or protection they have in the country of origin, on the condition that they are clearly adjusted to fit the definitions established in Article 92 and satisfy the other requirements established in the Law, as applicable.

In this case, the regulations for use and supervision shall be the same as in the country of origin, duly translated. Where no equivalent document exists, a detailed Spanish-language account of the production method shall suffice.

## TITLE XV

### EXPERTS AND EXPERT REPORTS

**Article 79.**– The expert reports required by the Law and the regulations shall be prepared by persons whose qualifications have already been vetted by the Director of the Department.

The experts referred to in the previous subparagraph shall be duly included in a special roster that the Department shall keep for this purpose and update regularly, in accordance with the nature of the requirements of the various applications for rights. The registration and removal of experts from the public list to be kept by the Department shall be done by decision of the Director of the Department, except as provided for in the final subparagraph of this Article.

All expert reports shall be signed by the professional who has issued them.

Given the specialized nature of certain applications, the Department may also commission, *ex officio* or at the request of the parties, technical reports from natural persons or legal entities. In the latter case, such reports shall be signed by the legal representative of the legal entity and the professional or professionals involved in the preparation thereof.

**Article 80.**– Without prejudice to the special rules established in the Law or in these Regulations, the applicant shall bear the cost of all expert reports. The fee for such examinations shall be fixed periodically, by means of a decision by the Director of the Department. Applicants shall have 60 days, according to Article 8 of the Law, to provide the Department with proof that the respective fee has been paid, prior to the appointment of the expert who is to analyze the application.

In cases described as special by the Department and where the nature of the subject matter contained in the application is highly complex, the Director of the Department may decide that it shall be studied simultaneously by two or more experts from different fields of knowledge. For this purpose, the applicant shall pay the fees fixed by the Department for each expert who has been appointed to study the application.

The expert reports described in Article 18bis A of the Law shall be assigned by the Director of the Industrial Property Department, who shall ensure equitable and equivalent distribution among the experts, taking into consideration the specialization of each of them.

**Article 81.**– An entry shall be made in the respective registration concerning the acceptance of the duty of expert, which shall be given no more than 20 days after his appointment. If this is not done within the said period, it shall be understood that he rejects the assignment and the Director of the Department shall appoint someone else, who shall enjoy the same period of time for acceptance or rejection.

Failure to accept an assignment shall give rise to a statement of grounds.

**Article 82.**– The expert’s work shall consist of the following:

- (a) deciding on compliance with requirements concerning the substance of the right, as indicated in Articles 32, 56, 62 and 75 of the Law;
- (b) assessing the technical adequacy of the content of the documents submitted by the applicant;
- (c) verifying prior art in the technical field to which the application relates;
- (d) preparing the expert report and submitting it to the Department.

**Article 83.**– Depending on the nature of the right being examined, the expert report shall contain:

- (a) a prior art search;
- (b) an analysis of novelty;
- (c) an analysis of inventive step;
- (d) an analysis of industrial applicability;
- (e) a technical analysis of compliance with the other requirements set out in the Law and the Regulations.

**Article 84.**– To analyze novelty in respect of similar industrial designs, the expert or examiner shall take the following into consideration, in addition to the provisions contained in Title V of the Law:

- (a) the external form. In this case, the new form shall not be directly related to the function it is designed to perform;
- (b) actual differences in respect of ornamental elements, compared with other similar designs or industrial objects. For such purposes, the ornamental elements shall be interpreted as three-dimensional form;
- (c) the area where the ornamental elements appear, compared with similar industrial designs or objects;
- (d) the distribution of the ornamental elements within the respective areas;
- (e) the body of external aspects with similar designs, in order to determine whether the design applied for is different.

**Article 85.**– The expert or examiner, through the Department, shall require the applicant to produce additional supporting material where he deems that the accompanying supporting material is insufficient to determine the existence of the requirements established by the Law in respect of each right.

**Article 86.**– Once the expert’s report has been issued, the applicant shall be notified accordingly through the daily bulletin, and shall be given a copy thereof as need be.

In cases where it deems this appropriate, the Department may, acting on its own initiative or at the request of the interested party, commission a second technical opinion. Said opinion shall be obtained from a second expert, a committee composed of experts in the respective technical field or the internal examiners appointed by the Director of the Department.

**Article 87.**– The Department shall study the expert report to verify and analyze the concepts evaluated in the expert examination and to confirm whether the opinion is consistent with that of the Department.

Expert reports shall be considered supporting material for the decision by the Director of the Department.

**Article 88.**– The expert or examiner shall conduct a search of prior art, for which he may use available national or international media.

To facilitate this task, the Department shall maintain a database composed of Chilean patents, foreign official gazettes and patents or any other technical material for the evaluation of prior art and background material. National searches shall also include visits by experts or examiners to research centers, universities or companies that can provide technical information on the requested subject matter.

In special cases, searches may be made with data from other countries, by virtue of the Department's agreements with foreign patent offices or international bodies. It may be necessary to determine whether this search should be conducted during the preliminary examination, the expert examination or any other stage of the processing of a right.

If this type of search is required during the expert examination, the deadline for preparing the report may be extended, in accordance with the provisions of Article 7 of the Law.

**Article 89.**— The Director of the Department shall make a call for public submissions via publication in the Official Gazette, for the purposes of preparing the list of experts whose names shall be on the roster for conducting technical examinations of applications for patents, utility models, industrial designs, and layout designs (topographies) of integrated circuits. Said list shall include the names of all of the persons who, in the opinion of the Director of the Department, are technically qualified to conduct said examinations, in the various areas where they are necessary.

The rules indicated in this Title shall not apply to expert reports different from the ones referred to in Article 8 of the Law.

## **TITLE XVI**

### **FINAL PROVISIONS**

**Article 90.**— Payment orders corresponding to the rights indicated in Article 18 of the Law shall be issued by the Department, in hard copy or electronically. It shall be necessary to show proof of payment, either physically or electronically.

### **TO BE NOTED, NOTIFIED AND PUBLISHED**

RICARDO LAGOS ESCOBAR  
PRESIDENT OF THE REPUBLIC

JORGE RODRIGUEZ GROSSI  
MINISTER OF ECONOMY,  
DEVELOPMENT AND RECONSTRUCTION